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HARRINGTON & SMITH 4 RESEARCH DRIVE, Suite 202 SHELTON, CT 06484-6212			EXAMINER NGUYEN, TUAN HOANG	
			ART UNIT	PAPER NUMBER
			2618	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/965,784

Applicant(s)

MCELWAIN ET AL.

Examiner

TUAN H. NGUYEN

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 20 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 22-27 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13, 15-17, 19, 28-30 and 32 is/are rejected.
- 7) ☒ Claim(s) 6, 14 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see applicant's remarks, filed on 06/19/2009, with respect to the rejection(s) of claims 1-17, 1-20 and 22-32 under 35 U.S.C § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made over Seazholtz et al. (US PAT. 5,920,821 hereinafter, "Seazholtz") in view of La Medica, Jr. et al. (US PUB. 2004/0214572 hereinafter, "La Medica").

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz et al. (US PAT. 5,920,821 hereinafter, "Seazholtz") in view of La Medica, Jr. et al. (US PAT. 6,625,451 hereinafter, "La Medica") and further in view of Bridges et al. (US PAT. 6,397,064 hereinafter, "Bridges").

Consider claim 1, Seazholtz teaches a method comprising: storing a system identification that identifies a home service provider for the mobile station (col. 9 lines

26-39); storing the identified plurality of system identification in a memory that is accessible by a mobile station (col. 8 lines 35-52); comparing a system identification received from a wireless service provider to the stored plurality of system identification (col. 8 lines 35-52).

Seazholtz does not explicitly show that identifying a plurality of system identification having a common spatial characteristic.

In the same field of endeavor, La Medica teaches identifying a plurality of system identification having a common spatial characteristic (col. 15 line 53 through col. 16 line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, identifying a plurality of system identification having a common spatial characteristic, as taught by La Medica, in order to provide user selectable modes of operation in a mobile communication station, which allow certain fall-back options when a preferred system may not be available, but still steers the bulk of the system selection operations to preferred systems.

Seazholtz and La Medica, in combination fails to teach upon any one of the plurality of stored system identification matching the received system identification, declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.

However, Bridges teaches upon any one of the plurality of stored system identification matching the received system identification (col. 3 lines 26-39), declaring

the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided (col. 3 lines 26-39, i.e., when the wireless service provider as being a home service provider, it is obviously that the mobile station is assumed to not be roaming and roaming charges are avoided).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bridges into view of Seazholtz and La Medica, in order for providing preferred wireless carrier information for use by a mobile station when the mobile station is roaming outside of a home market area.

Consider claim 32, Seazholtz teaches an apparatus, comprising: a wireless controller (col. 8 lines 35-52); a wireless transceiver controlled by the wireless controller (col. 8 lines 35-52); configured to compare a system identification received from a wireless service provider to the stored plurality of system identifications (col. 8 lines 35-52).

Seazholtz does not explicitly show that at least one memory, the at least one memory comprising a location for storing a system identification that identifies a home service provider for the apparatus, wherein said wireless controller is configured to identify a plurality of system identifications having a common spatial characteristic; configured to store the identified plurality of system identifications having the common spatial characteristic in the at least one memory.

In the same field of endeavor, La Medica teaches at least one memory, the at least one memory comprising a location for storing a system identification that identifies

a home service provider for the apparatus, wherein said wireless controller is configured to identify a plurality of system identifications having a common spatial characteristic (col. 15 line 53 through col. 16 line 4); configured to store the identified plurality of system identifications having the common spatial characteristic in the at least one memory (col. 15 line 53 through col. 16 line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, at least one memory, the at least one memory comprising a location for storing a system identification that identifies a home service provider for the apparatus, wherein said wireless controller is configured to identify a plurality of system identifications having a common spatial characteristic; configured to store the identified plurality of system identifications having the common spatial characteristic in the at least one memory, as taught by La Medica, in order to provide user selectable modes of operation in a mobile communication station, which allow certain fall-back options when a preferred system may not be available, but still steers the bulk of the system selection operations to preferred systems.

Seazholtz and La Medica, in combination fails to teach upon any one of the plurality of stored system identifications matching the received system identification, configured to declare the corresponding wireless service provider as being a home service provider for the apparatus such that the apparatus is assumed to not be roaming and roaming charges are avoided.

However, Bridges teaches upon any one of the plurality of stored system identifications matching the received system identification (col. 3 lines 26-39),

configured to declare the corresponding wireless service provider as being a home service provider for the apparatus such that the apparatus is assumed to not be roaming and roaming charges are avoided (col. 3 lines 26-39, i.e., when the wireless service provider as being a home service provider, it is obviously that the mobile station is assumed to not be roaming and roaming charges are avoided).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bridges into view of Seazholtz and La Medica, in order for providing preferred wireless carrier information for use by a mobile station when the mobile station is roaming outside of a home market area.

4. Claims 4, 7, 9-10, 12, 15, 17, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica and Bridges and further in view of McGregor et al. (U.S. PUB. 2001/0000777 hereinafter, "McGregor").

Consider claim 4, Seazholtz, La Medica and Bridges, in combination fails to teach the common spatial characteristic (information of the system operator code) is comprised of a geographical area that corresponds to a postal zone.

However, McGregor teaches the steps of identifying, storing, comparing and declaring are executed only if the mobile station is classified as being in a prepaid mode of operation (page 12 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Seazholtz, La Medica and Bridges, in order to provide the mobile phone unit having an internal processor with

accessible internal memory for storing the accounting program and call data for each call.

Consider claim 7, Seazholtz, La Medica and Bridges, in combination, fail to teach displaying a message to a user for informing the user that the user is operating in a Prepaid mode with one of a plurality of system providers having system identification that are associated with a geographical area that is the user's home geographical area.

However, McGregor teaches displaying a message to a user for informing the user that the user is operating in a Prepaid mode with one of a plurality of system providers having system identification that are associated with a geographical area that is the user's home geographical area (page 12 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Seazholtz, La Medica and Bridges, in order to provide the mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Consider claim 9, McGregor further teaches the common spatial characteristic is comprised of a geographical area that is defined by information received from a customer of a prepaid service provider (page 12 claim 25).

Consider claim 10, Seazholtz teaches a mobile station comprising: a processor configured to access at least one memory and that is responsive to a received system

identification for comparing received system identification to system identification in a list of system identification (col. 8 lines 35-52).

Seazholtz does not explicitly show that a list containing a plurality of other system identification having a common spatial characteristic.

In the same field of endeavor, La Medica teaches a list containing a plurality of other system identification having a common spatial characteristic (page 1 [0010]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, a list containing a plurality of other system identification having a common spatial characteristic, as taught by La Medica, in order for enabling multiple wireless service providers to use or provide services on a common wireless network infrastructure.

Seazholtz and La Medica, in combination, fail to teach in mobile stations associated with a prepaid service provider at least one memory storing a system identification that identifies a Home service provider for the mobile station.

However, McGregor teaches in mobile stations associated with a prepaid service provider at least one memory storing the system identification that identifies the Home service provider for the mobile station (page 2 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Seazholtz and La Medica, in order to provide the mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Seazholtz, La Medica and McGregor, in combination fails to teach upon any one of the plurality of system identification matching the received system identification, declaring a wireless service provider that transmitted the system identification as being the Home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.

However, Bridges teaches upon any one of the plurality of stored system identifications matching the received system identification (col. 3 lines 26-39), configured to declare the corresponding wireless service provider as being a home service provider for the apparatus such that the apparatus is assumed to not be roaming and roaming charges are avoided (col. 3 lines 26-39, i.e., when the wireless service provider as being a home service provider, it is obviously that the mobile station is assumed to not be roaming and roaming charges are avoided).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bridges into view of Seazholtz, La Medica and McGregor, in order for providing preferred wireless carrier information for use by a mobile station when the mobile station is roaming outside of a home market area.

Consider claim 12, McGregor further teaches the common spatial characteristic is comprised of a geographical area that is defined by information received from a customer of the prepaid service provider (page 12 claim 19).

Consider claim 15, McGregor further teaches a display for displaying a message to a user for informing the user that the user is operating in a Prepaid mode with one of

a plurality of system providers having system identification that are associated with a geographical area that is the user's home geographical area (page 12 claim 25).

Consider claim 17, Seazholtz teaches a mobile station, comprising: a controller (col. 8 lines 35-52); a wireless transceiver (col. 8 lines 35-52); and at least one memory comprising a location for storing a home system identification and other locations configured to store a plurality of cousin system identification (col. 9 lines 40-56).

Seazholtz does not explicitly show that the at least one memory is configured to store the cousin system identifications under the direction of a prepaid service provider, and the cousin system identifications correspond to system identifications associated with one or more service providers that service a predetermined geographical area that is defined to be a non-roaming area of a customer of the prepaid service provider, wherein the home system identification is configured to be stored in at least one memory without the direction of a prepaid service provider.

In the same field of endeavor, McGregor teaches the at least one memory is configured to store the cousin system identifications under the direction of a prepaid service provider, and the cousin system identifications correspond to system identifications associated with one or more service providers that service a predetermined geographical area that is defined to be a non-roaming area of a customer of the prepaid service provider, wherein the home system identification is configured to be stored in at least one memory without the direction of a prepaid service provider (page 12 claim 25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the at least one memory is configured to store the cousin system identifications under the direction of a prepaid service provider, and the cousin system identifications correspond to system identifications associated with one or more service providers that service a predetermined geographical area that is defined to be a non-roaming area of a customer of the prepaid service provider, wherein the home system identification is configured to be stored in at least one memory without the direction of a prepaid service provider, as taught by McGregor, in order to provide a mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Seazholtz, La Medica and McGregor, in combination fails to teach wherein said wireless controller is configured to declare a system identification received through said wireless controller to be a home service provider if the received system identification matches the stored home system identification or any one of the plurality of stored cousin system identification such that the mobile station is assumed to not be roaming and roaming charges are avoided.

However, Bridges teaches wherein said wireless controller is configured to declare a system identification received through said wireless controller to be a home service provider if the received system identification matches the stored home system identification or any one of the plurality of stored cousin system identification such that the apparatus is assumed to not be roaming and roaming charges are avoided (col. 3 lines 26-39, i.e., when the wireless service provider as being a home service provider, it

is obviously that the mobile station is assumed to not be roaming and roaming charges are avoided).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bridges into view of Seazholtz, La Medica and McGregor, in order for providing preferred wireless carrier information for use by a mobile station when the mobile station is roaming outside of a home market area.

Consider claim 28, Seazholtz further teaches the at least one memory is removable from the mobile station (col. 13 lines 24-30).

5. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica and Bridges and further in view of Mizikovsky (U.S. PAT. 5,983,115).

Consider claim 2, Seazholtz, La Medica and Bridges, in combination fail to teach the common spatial characteristic (information of the system operator code) is comprised of a geographical area that corresponds to a postal zone.

However, Mizikovsky teaches the common spatial characteristic (information of the system operator code SOC) is comprised of a geographical area that corresponds to a postal zone (col. 2 lines 54-64, fig. 2 illustrates a map of the United State cities such as Seattle, Chicago, and Washington D.C. had the same system operator code may be found in several different locations although on different frequency bands).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Mizikovsky into view of Seazholtz, La Medica

and Bridges, in order to locate a wireless service provider in a multi-service provider environment using a stored list of preferred service providers.

Consider claim 3, Mizikovsky further teaches the common spatial characteristic (information of the system operator code SOC) is comprised of a geographical area that corresponds to a ZIP code (col. 2 lines 54-64, Fig. 2 illustrates a map of the United State cities such as Seattle, Chicago, and Washington D.C. had the same SOC may be found in several different locations although on different frequency bands).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Mizikovsky into view of Seazholtz, La Medica and Bridges, in order to locate a wireless service provider in a multi-service provider environment using a stored list of preferred service providers.

6. Claims 5, 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica and Bridges and further in view of Bamburak et al. (U.S PAT. 6,807,418 hereinafter, "Bamburak").

Consider claim 5, Seazholtz, La Medica and Bridges, in combination fail to teach if none of the plurality of stored system identification matches the received system identification, further comprising comparing the received system identification to other stored system identification, including at least one of a Partner system identification, a Favored system identification and a Forbidden system identification.

However, Bamburak teaches if none of the plurality of stored system identification matches the received system identification, further comprising comparing

the received system identification to other stored system identification, including at least one of a Partner system identification, a Favored system identification and a Forbidden system identification (col. 11 lines 22-29).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bamburak into view of Seazholtz, La Medica and Bridges, in order to provide a method for locating a particular or desirable communications service provider in an environment having a plurality of service providers.

Consider claim 8, Bamburak further teaches the step of comparing includes a preliminary step of comparing the received system identification to the stored system identification that identifies the Home service provider for the mobile station, and upon a match declaring the service provider to be the Home service provider, and inhibiting the execution of the step of comparing the system identification received from a wireless service provider to the stored plurality of system identification (fig. 4 col. 5 line 20 through col. 6 line 7).

Consider claim 19, Bamburak further teaches the Cousin SIDs are stored in a memory that is detachable from said mobile station (col. 7 lines 2-11).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica, McGregor and Bridges, and further in view of Mizikovsky (U.S. PAT. 5,983,115).

Consider claim 11, Seazholtz, La Medica, McGregor and Bridges, in combination, fail to teach the common spatial characteristic is comprised of a postal zone, such as a ZIP code.

However, Mizikovsky teaches the common spatial characteristic is comprised of a postal zone, such as a ZIP code (col. 2 lines 54-64, Fig. 2 illustrates a map of the United State cities such as Seattle, Chicago, and Washington D.C. had the same SOC may be found in several different locations although on different frequency bands).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Mizikovsky into view of Seazholtz, La Medica, McGregor and Bridges, in order to locate a wireless service provider in a multi-service provider environment using a stored list of preferred service providers.

8. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica, McGregor and Bridges, and further in view of Bamburak.

Consider claim 13, Seazholtz, La Medica, McGregor and Bridges, in combination, fails to teach if none of the plurality of other system identification matches the received system identification, the processor compares the received system identification to other stored system identification found in an Intelligent Roaming Data Base (IRDB).

However, Bamburak teaches if none of the plurality of other system identification matches the received system identification, the processor compares the received

system identification to other stored system identification found in an Intelligent Roaming Data Base (IRDB) (col. 5 lines 41-48 and col. 10 lines 9-21).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bamburak into view of Seazholtz, La Medica, McGregor and Bridges, in order to provide a method for locating a particular or desirable communications service provider in an environment having a plurality of service providers.

Consider claim 16, Bamburak further teaches the processor first compares the received system identification to the stored system identification that identifies the Home service provider for the mobile station, and upon a match declares the service provider to be the Home service provider, and inhibits comparing the received system identification the list of other system identification (fig. 4 col. 5 line 20 through col. 6 line 7).

9. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz, La Medica, McGregor and Bridges, and further in view of Osmani et al. (U.S PAT. 5,815,807 hereinafter, "Osmani").

Consider claim 29, Seazholtz, La Medica, McGregor and Bridges, in combination, fails to teach the mobile station operates in a Postpaid mode.

However, Osmani teaches the mobile station operates in a Postpaid mode (col. 1 lines 42-49).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Osmani into view of Seazholtz, La Medica, McGregor and Bridges, in order to enhance a wireless communication device operates in a wireless communication system to provide a user of the device with portable communications.

Consider claim 30, Osmani further teaches the mobile station has both Postpaid and Prepaid modes (col. 1 lines 42-49).

Allowable Subject Matter

10. Claims 6, 14, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

11. Claims 20 and 22-27 are allowed over the prior art record.
12. The following is an examiner's statement of reasons for allowance:

The applicant's remarks, filed on 06/20/2008, have been carefully reviewed with updated search. Consequently, reasons for allowance of claims 20 and 22-27 are set forth in according to the applicant's remarks state on pages 10-22.

Conclusion

13. Any response to this action should be mailed to:

Mail Stop_____ (Explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan H. Nguyen/
Examiner
Art Unit 2618